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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,347	05/09/2005	Hansjorg Ander	RO4016US (#90568)	4202
7590 D. Peter Hochberg Co. 1940 East 6th St. 6th Floor Cleveland, OH 44114			EXAMINER BERNSHTEYN, MICHAEL	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 03/21/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,347

Applicant(s)

ANDER ET AL.

Examiner

MICHAEL M. BERNSTEYN

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This Office Action follows a response filed on February 13, 2008. Claim 1 has been amended; no claims have been cancelled or added.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 13, 2008 has been entered.
3. In view of the amendment(s) and remarks the objection of claim 1 and the rejection of claims 1-13, 15 and 16 under 35 U.S.C. 112, 1st paragraph have been withdrawn.
4. Applicant's arguments with respect to claims 1-13, 15 and 16 have been considered but are moot in view of the new ground(s) of rejection.
5. Claims 1-13, 15 and 16 are pending.

Claim Rejections - 35 USC § 102

6. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

7. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
8. Claims 1-9, 12, 13 and 16 are rejected under 35 U.S.C. 103(a) as being anticipated by Hoene et al. (EP 0 039 797 A1).

With regard to the limitations of claims 1-9, 12, 13 and 16, Hoene discloses a pressure-sensitive adhesive consisting of (A) a copolymer having a softening point of minus 60 to 0°C derived from (a) 60 to 99.88% by weight of an ester of acrylic or methacrylic acid with an alkanol of 4 to 12 carbon atoms, (b) 0.1 to 5% by weight of at least one monomer having at least one hydroxyl group, (c) 0.02 to 5% by weight of at least one monomer having at least one tert.-amino group, and (d) 0 to 30% by weight of other copolymerizable monomers, (B) such an amount of a polyisocyanate having at least two isocyanate groups per molecule that 0.001 to 1 equivalent of isocyanate groups is present per equivalent of OH groups of monomer (b), (C) 10 to 90% by weight, based on the amount of (A), of an organic solvent which is inert to (A) and (B), and optionally (D) conventional additives (abstract). The adhesive has high tack on glass, metal, polycarbonate and other polar and semipolar substrates, and not having an perceivable reaction upon contact to isocyanate (page 1, lines 14-18).

Hoene discloses the species which are substantially identical to the claimed species, and their weight ratios are within the claimed ranges (page 2, line 26 through page 9, line 9; in particular page 3, lines 26-29; page 4, lines 6-19 and 23-26; page 4, line 27 through page 5, line 13; etc.).

9. Claims 10-11, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Hoene et al. (EP 0 039 797 A1) in view of Weaver et al. (U. S. Patent 6,713,641).

The disclosure of Hoene resided in § 8 is incorporated herein by reference.

With regard to the limitation of instant claims 10-11, 14 and 15, Hoene does not disclose that (meth)acrylated polyesters are conversion products of OH-terminated polyesters polyols with (meth)acrylic acid or reaction products of carboxyl groups-containing polyester polyols with hydroxyl groups-containing (meth)acrylates; and (meth)acrylated polyurethanes are conversion products of amine- or hydroxyl-terminated (meth)acrylates with diisocyanates or polyisocyanates.

Weaver discloses a coating composition wherein the polymerizable vinyl compounds comprise a solution of a polymeric, polymerizable vinyl compound selected from acrylated and methacrylated polyesters, acrylated and methacrylated polyethers, acrylated and methacrylated epoxy polymers, acrylated or methacrylated urethanes, and mixtures thereof, in a diluent selected from monomeric acrylate and methacrylate esters (claim 17, col. 25, lines 24-31). The acrylated or methacrylated polymers and oligomers typically are combined with monomers, which contain one or more acrylate or methacrylate groups; e.g., monomeric acrylate and methacrylate esters, and serve as reactive diluents. The unsaturated polyesters, which are prepared by standard polycondensation techniques known in the art, are most often combined with either styrene or other monomers, which contain one or more acrylate or methacrylate groups and serve as reactive diluents (col. 13, lines 9-17).

Both references are analogous art because they are from the same field of endeavor concerning coating and pressure sensitive adhesive polymer compositions.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate acrylated and methacrylated polyesters acrylated or methacrylated urethanes as taught by Weaver in Hoene's pressure sensitive adhesive polymer composition because such combination with acrylate and methacrylate esters are suitable as adhesive and coating for such substrates as metals, aluminum, steel, plastics, glass, wood, paper, and leather (US'641, col. 2, lines 62-65), and thus to arrive the subject matter of claims 10-11 and 14-15.

10. Claims 1-9, 12, 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Czech et al. (EP 0 413 301 A1).

With regard to the limitations of claims 1-9, 12, 13 and 16, Czech discloses a method for producing contact adhesives by a polymerization reaction using (meth)acrylic acid and/or derivatives in an inert liquid medium, the liquid medium forms part of the contact adhesive after the polymerization. The ready-to-use state of the contact adhesive is brought about by a crosslinking reaction (abstract).

Czech discloses the pressure-sensitive adhesive consisting of (a) 60-90% by weight of at least one of an ester of acrylic or methacrylic acid; (b) 1 to 25% by weight of at least one monomer of acrylic or methacrylic acid having at least one hydroxyl group; (c) 0.5 to 11% by weight of at least one of N-substituted derivative of an ester of acrylic or methacrylic acid; (d) 0.1 to 10% by weight of at least one of vinyl carbonate; 0.05 to 1% by weight of radical initiator and 5 to 40% by weight at least one of polyols having

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molecular weight from 200 to 1,000. Czech discloses the species which are substantially identical to the claimed species, and their weight ratios are within the claimed ranges (claims 1-15; page 2, line 13 through page 3, line 36; examples in Tables 1 and 2).

The adhesive has high tack on glass, metal, polycarbonate and other polar and semipolar substrates, and not having a perceivable reaction upon contact to isocyanate (page 8, claim 13).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796

/Michael M. Bernshteyn/
Examiner, Art Unit 1796

/M. M. B./
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